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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/834,017      | 04/12/2001  | David H. Cox         | 45784-00052         | 5254             |

7590 04/08/2002

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EXAMINER

RAJGURU, UMAKANT K

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1711     | 4            |

DATE MAILED: 04/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

FD-4

|                              |                 |                |  |
|------------------------------|-----------------|----------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)   |  |
|                              | Examiner        | Group Art Unit |  |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Response**

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- Claim(s) 1-12 is/are pending in the application.
- Of the above claim(s) 6-12 is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-5 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 3 & 2  Interview Summary, PTO-413
- Notice of References Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a wood additive composite, classified in class 524, subclass 27.
  - II. Claims 6-12, drawn to a method for formulating above composite, classified in class 428, subclass 481.

The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product such as a laminate having alternate layers of an adhesive and substrate.

2. During a telephone conversation with Attorney Sung I. Oh on Feb 11, 2002 a provisional election was made without traverse to prosecute the invention of I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-12 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

*Not aff'd in  
ed  
Oct 23, 2002*

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder et al (WO 00/64-228).

(Schroeder is a record on PTO-1449, paper #3).

Sschroeder discloses compression molded cellulose loudspeaker cabinets (title). The cabinet comprises cellulose, thermoset resin (25-85%) and a catalyst (1-5%), milled glass fibers, fine wood flour, course wood flour and few other ingredients (p.6, line 17 to p. 7, line 2). Polyester thermoset resins are suitable. Fine wood flour may be 100-200 size and course wood flour 10-50 mesh size (p. 7, lines 3-8).

Schroeder does not mention a dye as an additive.

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Since it is customary practice to add dyes or pigments to a composition to impart certain color, it would have been obvious to add any suitable dye to the composition for cabinets of Schroeder in order to produce the desired color and thus arrive at instant invention.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-4 are rejected under 35 U.S.C. 102(a) as being anticipated by Schroeder et al (WO 00/64228).

(Schroeder is of record on PTO-1449, paper # 3).

Disclosure of Schroeder summarized in item 5 above proves that above claims lack novelty.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. K. Rajguru whose telephone number is 703 308-2336. The examiner can normally be reached on Monday-Friday from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beck Shrive can be reached on 703 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-0661.

*Withdrawn  
Oct 22, 2002*

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*JKR*  
Rajguru/af  
April 4, 2002

*James J. Seidleck*  
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